



HT-01-022

July 15, 2003

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7-30-03

To: Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Attn: Art Unit 2653 - David Louis Ometz

From: George O. Saile, Reg. No. 19,572

28 Davis Avenue

Poughkeepsie, N. Y., 12603

RECEIVED

JUL 25 2003

Technology Center 2600

Subject: | Serial No.: 10/050,644 01/16/02 |

Min Li et al.

FeTa NANO-OXIDE LAYER AS A CAPPING  
LAYER FOR ENHANCEMENT OF GIANT  
MAGNETORESISTANCE IN BOTTOM SPIN  
VALVE STRUCTURES

|\_ Art Group: 2653 David Louis Ometz\_|

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Restriction or Election  
Requirement in the Office Action dated 06/27/03. In that  
Office Action, restriction was required to one of two stated

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being  
deposited with the United States Postal Service as first class  
mail in an envelope addressed to: Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450, on July 22, 2003.

Stephen B. Ackerman, Reg.# 37761

Signature/Date

 7/22/03

Inventions under 35 U.S.C. 121. The Inventions stated are Group I - Claims 1-44 to a method of annealing, classified in Class 148, subclass 108 and Group II - Claims 45-83 to a spin valve MR sensor, classified in Class 360, subclass 324.1.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group I - Claims 1-44 drawn to a process classified in Class 148, subclass 108. This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action. The Examiner gives the reason for the distinctness of the two inventions as (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). However, upon reading the product Claims against the process Claims one can readily see that the product Claims are directed to "a bottom spin valve magnetoresistive sensor element" and the process Claims are directed to "a method for forming a bottom spin valve magnetoresistive sensor element", it is necessary to obtain claims in both the product and method claim language. The method Claims necessarily use the product and vice versa. The field of search must necessarily cover both the method class/subclass

148/108 and products class 360/324.1 in addition to other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case, the product as claimed could be made by another and materially different process such as by one that does not require the particular steps of thermally annealing the sensor in a prescribed succession of temperatures in the presence of a corresponding sequence of external magnetic fields as required by invention I for patentability", is very speculative and really has nothing to do with the Claims as presented in this Patent Application. Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement and the Allowance of the present Patent Application is requested.

Sincerely,

A handwritten signature in black ink, appearing to be 'SBA', written over a horizontal line.

Stephen B. Ackerman, Reg.# 37761